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EXAMINER	
RIMELL, SAMUEL G	
ART UNIT	**PAPER NUMBER**
2175	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/458,899	WARD, STEPHANIE
	Examiner	Art Unit
	Sam Rimell	2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13, 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Goetz et al. ('650).

Claim 1: FIG. 26 illustrates a first template which illustrates emergency contact information (a home address), medical history information (the patient's name, which is a necessary part of a medical history), and personal information (the patient's insurance company). A second template (FIG. 29) provides medication information. All of the data illustrated in FIGS. 25-43 is linked together and stored in the memory of portable device (104). Each of the screen displays of FIGS. 25-43 are linked together and form a total medical report. Col 6, line 10 refers to the presence of a printer in the pharmacy that prints on sheets of paper. A printer is inherently capable of printing any data from the computer that accesses that data. Since the pharmacy computer can access all of the commonly shared data via the smart card, the printer can print any of the claimed data on at least one sheet of paper.

Claim 2: The first template (FIG. 26) provides for the entry of insurance data, in particular, the insurance policy number defined by the patient's insurance company.

Claim 3: The first template (FIG. 26) provides for entry of the insurance policy data, which also reads as pharmacy information, since an insurance policy can and will be used by a pharmacy.

Claim 4: The second template (FIG.29) includes a time section (the fifth line down) in which the timing of the medication is provided. Each of the times listed in the fifth line (8AM, 12 noon and 6PM) represents a separate column of data.

Claim 5: FIG. 30 provides a graphic illustration in the form of a text description (lines 1-3 of FIG. 30) which describe the appearance of each medication taken. Each graphic illustration is associated with each medication. For example, the medication Canderil shown in FIG. 29 is linked to the graphical description of Canderil in FIG. 30.

Claim 6: Any of the data shown in medical information screen of FIG. 29 reads as prescribing physician information since all of the information is provided from a prescribing physician.

Claim 7: FIG. 44 illustrates a database of medication information (206) with associated attributes, such as interactions and severities which can be reported to the patient.

Claim 8: As seen in step (214) of FIG. 44, an interaction report is generated if a drug interaction problem is detected.

Claim 9: The display screen of FIG. 40 represents a pillbox map. The information is linked to the medication information of FIG. 29, indicates a medication that needs to be taken and associates the medication with a particular time of day.

Claim 10: Any of the data displayed in FIG. 40 reads as a generated label, such as the indication of the time, or the icons for acceptance or delay of the instructions provided.

Claim 11: The display of FIG. 30 is a medication planner function, since it allows planning or replanning of the dosage scheduling. Each row includes medication information and specific times at which to take the medication.

Claim 12: An LCD screen is a sheet that displays data on only one side. (By the term "one sided sheet", it is presumed that applicant is referring to printing on only one side).

Claim 13: Any of the information in the screens of FIGS. 25-43 are readily observable by either the patient or medical personnel.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-13 are rejected, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. Patent 6,421,650).

Claim 1: Claim 1 includes all of the features as set forth in the previous description of claim 1. However, in an alternative interpretation, it is assumed that the printer at the pharmacist's computer is only disclosed as printing the prescription information, rather than the entire medical record of the patient. However, examiner maintains that it would have been obvious to modify the method of Goetz et al. so as to call for the pharmacist to print the entire patient record as a backup to the computer stored record in the event of computer error or

computer fault. This would prevent the electronic record from being vulnerable to loss, since the paper record would backup the electronic record. The print out would include at least one page.

Claims 2-13: See remarks for claims 2-13 as previously recited in this action.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. Patent 6,421,650).

Claim 26: As set forth with respect to claim 5 above, FIG. 30 of Goetz et al. provides a graphic illustration in the form of a text description of the size and color of a medication pill, but not a symbol having the size and shape of the pill. However, the skilled artisan would have readily recognized that a graphical user interface having a text description describing the size and color of an object could have been supplemented by a graphical picture of that same object. Alternatively, the picture could have been a substitute for the text description.

It would have been obvious to one of ordinary skill in the art to modify Goetz et al. to include pictures of medications, as a supplement to or substitute for a textual description of the medication pills, as a choice of design for a graphical user interface.

Remarks

Declaration under 37 CFR 1.132: The declaration under 37 CFR 1.132 has been reviewed and fully considered. A declaration under 37 CFR 1.132 cannot overcome a rejection under 35 USC 102, so the declaration is moot in with respect to the rejection of claims 1-13 under 35 USC 102(e).

However, a declaration under 37 CFR 1.132 is applicable to rejections applied under 35 USC 103(a) that involve the question of obviousness. Long felt need, which is the issue raised by applicant, is one factor that may be considered.

In reviewing the declaration, examiner finds that this affidavit does not establish long felt need by those of ordinary skill in the art (See MPEP 716.04). The declaration is addressed exclusively to applicant's own experiences and findings, and not findings by other practitioners in the art, particularly, practitioners having ordinary skill in the art. Accordingly, the declaration is not found to conclusively establish long felt need by persons of ordinary skill in the art.

Applicant's Arguments: Applicant's arguments are primarily directed to the amendment to claim 1, which calls for printing of the record on a one-sided sheet of paper. Only claim 1 is amended.

Examiner maintains that this feature is taught by Goetz et al. Col. 6, line 10 of Goetz refers to a printer in a pharmacy. A printer is inherently capable of printing any data from the computer that accesses that data. Since the pharmacist computer has access to all of the data via the smart card, it can print all of the data on the smart card. The print out would cover at least one sheet of paper.

As an alternative interpretation, examiner finds that it would have been obvious to perform the step of printing the entire record on at least one sheet of paper. Goetz et al. already discloses the printer in the pharmacy and printing the entire patient record would have the advantage of providing a backup to the electronic record in the event that the computer system should experience a fault or failure.

An additional issue arises in the question of having the record on a single sheet of paper. Applicant argues that in the Goetz et al. system it is plausible that the report could be printed on multiple sheets of paper.

However, the preamble of claim 1 includes the phrase "comprising the steps of". This means that the elements listed in the claim are only the minimum number of elements necessary to perform the method. When applying the prior art, this means that the prior art must demonstrate at least one sheet being printed on and not only one sheet being printed on. Since the printer in the pharmacy of Goetz et al. would print on at least one sheet it meets the requirements of the claim that call for printing on a sheet of paper. The claim does not state that sheet is the only sheet being printed on. Furthermore, even if the claims did contain such a limitation, examiner would find such feature to have been obvious for a number of different reasons. The skilled artisan would readily recognize the ability to control font size, line spacing and degree of detail such that the report could be any length desired.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

Sam Rimell
Primary Examiner
Art Unit 2175